

MAY 28 2003

FULBRIGHT & JAWORSKI
600 Congress Avenue
SUITE 1900
Austin, TX 78701

In re Application of	:
Sangar, et al .	:
Serial No.: 09/587,653	: Petition Decision
Filing Date: 5 June 2000	:
Attorney Docket No. UTSG:231US	:

This letter is in response to the Petition under 37 CFR 1.144, filed on 30 December 2002, to require the examiner to reconsider the restriction requirement advanced on March 27, 2002. The delay in acting upon this petition is regretted.

BACKGROUND

This application was filed with 50 original claims. The Examiner required a restriction into four inventions on 3 October 2001. On 30 January 2002 Applicant elected without traverse to prosecute invention II, claims 19-21 and 27-33, drawn to methods of producing a virus. However, Applicant also added claims 51-55 which depended upon claim 19, and are also drawn to methods of producing a virus. On 27 March 2002, the Examiner withdrew the newly added claims 51-55 from consideration stating they were drawn to a non-elected invention. A first office action the merits was sent out rejecting claims 19-21 and 28-30 under 35 USC 101, claims 19-21 and 27-33 under 35 USC 112, second paragraph and claims 19-21 and 28-30 under 35 USC 102(b). Applicant responded on 05 July 2002 by amending the claims and adding new claim 56, which depended upon claim 19. In addition, Applicant traversed the withdrawal of consideration of claims 51-55 as being drawn to a non-elected invention. On 21 October 2002, the Examiner responded to Applicant's traversal of the restriction requirement by upholding the withdrawal of claims 51-55 and removing all other grounds of rejection, except for the 35 USC 112, second paragraph and made the office action Final. In response on 30

Not 1.114 → should be 1.144 [1.114 = RCE]

December 2002, Applicant filed an amendment After-Final under 37 CFR 1.116, and a Petition under 37 CFR 1.114 to remove the restriction requirement. On 21 January 2003, the Examiner denied entry of the After-Final amendment. On 4 March 2003 Applicant filed a notice of Appeal, and on 5 May 2003 Applicant filed an Appeal Brief and another amendment After-Final under 37 CFR 1.116. The Examiner has not yet considered the After-Final amendment or the Appeal Brief.

DISCUSSION

The Examiner removed claims 51-55 from elected group based upon her decision that claims drawn to a method of making a virus comprising 250 or more contiguous nucleotides of SEQ ID NO. 2 are ultimately limited to nucleotides which differ in structure from the originally elected group of a method of making a virus comprising 50 or more contiguous nucleotides of SEQ ID NO. 1. However, as Applicant as correctly pointed out in their Petition, claims 51-55 properly depend from the elected invention of claims 19-21, 27-33, and 56 and require SEQ ID NOS 1 and 2 together and not in the alternative. In addition, SEQ ID NO. 2 encompasses all of SEQ ID NO. 1. Therefore a search comprising SEQ ID NO. 1 would be co-extensive with a search of SEQ ID NO. 2 and an undue search burden does not exist.

DECISION

The Petition is **GRANTED** for the reasons set forth above. The withdrawal from consideration of claims 51-55 from claims 19-21 and 27-33 mailed 27 March 2002 has been vacated. Claims 51-55 will be rejoined for examination with presently acted upon claims 19-21, 27-33 and 56. The Appeal Brief filed 5 May 2003 will not be considered and the application will be returned to the Examiner for action addressing claims 51-55 in a manner consistent with this petition decision.

Applicants may file a request for the refund for the Notice of Appeal fee.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, PO Box 1450, Alexandria VA 22313-1450 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7230.

Jasemine C. Chambers

Jasemine Chambers
TC1600 Group Director